In the Supreme Court of the United States

OCTOBER TERM, 1978

No. 78-1322

PITTWAY CORPORATION,

Petitioner,

v.

HAROLD BURKE, et al,

Respondents.

OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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REASONS FOR DENYING THE PETITION

Petitioner (hereinafter "Pittway") asks this Court to answer the following question (Petition p. 2):

> "Whether the accepted jurisdictional test applicable in determining whether an action 'arises under' the federal courts' non-exclusive federal jurisdiction (28 U.S.C. §1331(a)) is equally applicable in determining whether the action is one 'arising under' the federal courts' exclusive jurisdiction in patent cases (28 U.S.C. §1338(a))?"

Contrary to Rule 23(c) of the Rules of this Court the question is not "expressed in the terms and circumstances of the case." The question presented is expressed at a level of abstraction and universality which is shunned by judges. The question posed here by Pittway was raised in *Enders* v. *Amer-*

ican Patent Search Co., 535 F2d 1085 (9th Cir. 1976), cert. den. 429 U.S. 888. The court left the question unresolved but commented, inter alia, (535 F2d p. 1088, note 2):

> "There would be nothing novel about construing the same 'arising under' phrase differently in different contexts."

Illinois' subject matter jurisdiction over the complaint would not be ousted even if "arising under" in 28 U.S.C. §1338(a) were interpreted as precisely synonymous with "arises under" in 28 U.S.C. §1331(a). No aspect of federal patent law is essential to plaintiffs' success in the present case.

In the court below Pittway contended that the court is "necessarily required" (Petition p. 15) by the present complaint to construe and apply various sections of the Patent Act. In the court below Pittway concentrated most emphatically on the assertion that the patentability or validity of claim 13 of the Original Patent Application was crucial for the determination of the merits of the complaint. For example, on page 17 of its Petition For Rehearing in the court below Pittway summarized its argument as follows:

> "In sum, the cause of action asserted in each of counts I, II, IV, V and VI depends on the allegations that claim 13 was patentable (valid), and should have been obtained as part of the Original Patent."

With respect to each of the counts pleaded in the complaint Pittway's last quoted argument was analyzed and rejected by the court below (Petition pp. 7a, 9a):

> "The [contractual] requirement that Pittway properly prosecute patent applications is not based upon the patentability of the inventions covered by the applications."
>
> * * *
>
> "Pittway asserts that its obligation to prosecute the Original Patent Application was limited to the prosecution of those claims which are allowable. That Claim 13, or other claims related to the Original Patent Application, would not be allowed is a defense raised by Pittway and not a prerequisite to proof of the cause of action alleged by plaintiffs."

Thus the merits of the complaint under Illinois law do not turn on patentability or patent validity, i.e., the construction and application of 35 U.S.C. §§102, 103 and 112. Patent invalidity or unpatentability of claims in a patent application can become subjects of this litigation only if Pittway were to plead them defensively and were allowed to offer supporting evidence at the trial. Insofar as the complaint charges Pittway with "bad faith" and "breach of its fiduciary duty" (Petition pp. 21a, 22a, 23a, 25a, 27a) patent invalidity or lack of patentability cannot be raised as defense, *Roberts* v. *Sears, Roebuck & Co.*, 573 F2d 976, 982 (7th Cir. 1978), cert. den. 99 S. Ct. 179.

Pittway also argues that the complaint requires interpretation and application of 35 U.S.C. §§252, 271 and 282 (Petition pp. 14-15). Pittway's presentation of this argument in the court below was not as elaborate as the presentation of the validity and patentability argument. Only the last two and one half pages of Pittway's Petition For Rehearing in the court below dealt with the purported necessity of interpreting and applying 35 U.S.C. §§252, 271 and 281. This disparity in Pittway's emphasis may be one reason why the opinion of the court below contains little comment specific to the three last cited sections on the patent laws. Nevertheless the court below rejected Pittway's argument in toto by observing toward the end of its opinion (Petition p. 12a):

> "The entire cause of action is based upon Pittway's alleged failure to comply with certain provisions of the contract regarding prosecution and patent applications, notice, and payment of royalties."

Thus Illinois law warrants recovery under the complaint without any need for interpreting and applying any provision of the Patent Act. Under Illinois law questions of patent law are not essential to the complaint. If such questions arise at all, they arise only by way of defense or collaterally. Pittway has not asked this Court to review and modify the Illinois law governing the breaches of contract and other claims alleged in the complaint or the allocation of the burden of proof with respect to potential defenses.

CONCLUSION

In view of the unchallenged substantive law of Illinois the resolution of the abstract question posed by Pittway could not remove the complaint from the subject matter jurisdiction of the Illinois courts. Consequently the petition should be denied.

Respectfully submitted,

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